

Appln No. 09/609,596  
Amdt. Dated 24 January 2005  
Response to Office Action of 9 December 2004

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## REMARKS/ARGUMENTS

### *Claims*

The Examiner has rejected claims 1-19. In response to the outstanding Office Action claims 1, 7 and 11 have been amended. Therefore, claims 1-19 remain pending in the application.

### *Claims Rejections – 35 U.S.C. § 103*

Claims 1-19 were rejected under 35 U.S.C. § 103(a) as being obvious over Montlick (US 5,561,446), and further in view of Baldwin (US 5,884,425). The rejection is respectfully traversed.

The Examiner has asserted that the central computer system of Montlick discloses software for accessing digitally stored forms, which may take the form of a "printed registration form", and transmitting those forms to pen-based computers. However, to be transmitted to the pen-based computers, the forms according to Montlick must be in a digital format, otherwise 1) they can not be viewed on the pen-based computers, and 2) a stylus can not be pressed to a display on the computers at the location on the display where a menu item appears. This highlights a disadvantage of the teachings of Montlick, which is that in order to access the central computer system and view the digital forms people must carry around portable pen-based computers that have wireless communication capability.

The method and system of the present claimed invention advantageously does not require a user to carry around pen-based computer display screens. To access the computer system of the present invention a user only needs a printed paper form with coded data printed thereon and a sensing device (e.g., the pen-like netpage pen 101) capable of sensing the data encoded on the paper form. The sensing device of the present invention is used to detect (sense) the coded data printed on the paper form and transmit the results of this detection to a computer system.

Simply by carrying a sensing device and using the sensing device to address a paper form the present invention allows the user to communicate information to the computer system. In the present claimed invention the computer system receives from the sensing device data encoded on the printed form and data related to the action of the sensing device in relation to the paper form; the paper form having coded data printed thereon. More specifically, the present claimed invention recites that the computer system receives from the sensing device data including at least a) information regarding an identity of the sensing device, b) the identity of the form, and c) at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data. At least, the sensing device of the present invention and the interaction of the sensing device with the printed registration form (in paper form) with coded data printed thereon distinguish the present invention from Montlick, and further, this distinction is plainly recited in both pending independent claims. These limitations which are recited in both pending independent claims are not trivial; on the contrary, as discussed above, the present claimed invention has the advantageous effect of portability over and above that of the prior art.

Montlick does not teach or suggest c) at least one action of the sensing device in relation to the form (the form defined in both pending independent claims as a paper form with coded data printed thereon) generated by the sensing device using at least some of the coded data, as recited in both pending independent claims. A pen-based computer with stylus operating with digitized forms, such as that taught by Montlick, does not have the

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capability of acting as a sensing device using coded data printed on a paper form, which is recited in both pending independent claims.

Additionally, Montlick does not teach or suggest "providing a printed registration form on paper, the paper form including registration information and coded data thereon". In fact, by requiring printed registration forms to be converted to digital format Montlick teaches away from the use of printed forms, and teaches away from the present claimed invention.

Further, the Examiner admits that Montlick does not explicitly mention, as recited in both pending independent claims, "the coded data being in the form of a plurality of tags". The Examiner asserts that Baldwin discloses tags with variable print information. The tags of Baldwin are made from polyolefin film, have an adhesive section by which they are affixed to the articles which the tags are designed to protect from theft, and contain print information such as bar codes or prices. In relation to the subject claimed invention the teachings of Baldwin do not make up for the deficiencies of Montlick.

The tags of Baldwin are polyolefin and are not digitized. It is not possible to combine the system of Montlick with the polyolefin tags of Baldwin as the interface of Montlick is only able to operate with digitized forms. The system of Montlick is designed to allow users to view pre-designed, pre-programmed digital forms not adhesive polyolefin labels.

The applicants consider that any combination of the teachings of Montlick and Baldwin would result in an inoperable method/system. Although the applicants recognize that in a proper rejection under 35 USC 103(a) combining the teachings of references does not involve an ability to combine their specific structures, nevertheless "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)" (MPEP 2143.01). For the sake of completeness the applicants will discuss what would happen if one attempted to combine the teachings of Montlick and Baldwin. The applicants consider that there are two ways to combine the teachings of Montlick and Baldwin. The first possible combination is to digitize the polyolefin tags of Baldwin, and the second possible combination is to use the non-digitized tags of Baldwin. The applicants discuss both combinations below.

If the tags of Baldwin were digitized, it would certainly not be possible for a combined Montlick-Baldwin computer system to receive data from a sensing device (presumably the pen-based computer) including information regarding at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data, where the coded data are printed on the paper form, as recited in both pending independent claims. In fact, by requiring a digitized form the sensing device, as taught by this combination of the teachings of Montlick and Baldwin, would then never be able to act in relation to a paper form with coded data printed thereon, as recited in both pending independent claims.

If one attempted to use the non-digitized polyolefin tags of Baldwin with the teachings of Montlick, the pen-based computer, consisting of a screen and stylus, of Montlick (the sensing device) would not be able to generate data including at least one action of the sensing device in relation to the non-digitized polyolefin tags as a result of the sensing device using at least some of the coded data printed on the non-digitized polyolefin tags. The pen-based computer, consisting of a screen and stylus, as taught by Montlick is clearly inoperable with non-digitized polyolefin tags.

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Neither Montlick or Baldwin, taken alone or in any possible combination teach or suggest "receiving in a computer system indicating data from a sensing device, the indicating data including...at least one action of the sensing device in relation to the form generated by the sensing device using at least some of the coded data", where the form is printed on paper and the paper form has coded data printed thereon, as is plainly recited in both pending independent claims. Neither of the possible combinations of the teachings of Montlick and Baldwin is able to teach or suggest the present claimed invention or the advantageous effects thereof.

The applicants believe that the above arguments alone effectively traverse the rejections of the Examiner. Nevertheless, in order to further clarify the distinctions between the present claimed invention and the prior art of Montlick and Baldwin, the present independent claims have been amended to clarify that the sensing device senses the coded data printed on the paper forms.

Support for the present amendments is found in the specification as originally filed at, for example, page 14, lines 28-29: "A tag is sensed by an area image sensor in the netpage pen, and the tag data is transmitted to the netpage system via the nearest netpage printer."

It is respectfully submitted that all of the Examiner's rejections have been successfully traversed. Accordingly, it is submitted that the application is now in condition for allowance. Reconsideration and allowance of the application is courteously solicited.

Very respectfully,

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